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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,517	06/30/1999	ROBERT BURNETT	A7489	8018
24587	7590	11/03/2004	EXAMINER	
ALCATEL USA INTELLECTUAL PROPERTY DEPARTMENT 3400 W. PLANO PARKWAY, MS LEGL2 PLANO, TX 75075				FERRIS, DERRICK W
		ART UNIT		PAPER NUMBER
		2663		

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/343,517	BURNETT, ROBERT	
	Examiner	Art Unit	
	Derrick W. Ferris	2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 July 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-6 and 24-27 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 27 is/are allowed.
- 6) Claim(s) 1,3-6 and 24-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 October 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/29/2004 has been entered.

Response to Amendment

2. **Claims 1, 3-6 and 24-27** as amended are still in consideration for this application. Applicant has added claim 27.

3. Examiner withdraws the obviousness rejection to *Mazzola* in view of *Katz* for Office action filed 03/22/04 based on the clarification in examiner's Advisory Action filed 07/21/2004. Also note the allowable subject matter for newly added claim 27.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 3-6, and 24-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,461,624 to *Mazzola* in view of "TUBA: Replacing IP with CLNP" by *Katz et al.* ("Katz") and "Use of ISO CLNP in TUBA Environments" to *Piscitello*.

In making a proper obviousness rejection under MPEP 706.02(j), the examiner will address the following four steps:

- a) *the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers where appropriate;*
- b) *the difference of differences in the claim(s) over the applied cited references;*
- c) *the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and*
- d) *an explanation why one skilled in the art at the time of the invention was made would have been motivated to make the proposed modification.*

As such to **claims 1, 5-6, and 24-26**, for step (a) *Mazzola* discloses IS gateway devices in figure 2b where the protocols for the gateway devices are disclosed in figure 4b. *Mazzola* clearly discloses routing CLNP over SONET using a DCC channel as is known in the art (see figure 4a).

For step (b) *Mazzola* is silent or deficient to routing IP over SONET (i.e., a “synchronous optical network”).

Katz cure the deficiency by disclosing that IP maps (i.e., “translates”) to CLNP [see section “Mapping IP functionality to CLNP” starting on page 44 of *Katz*]. *Piscitello* further clarifies that IP and CLNP are networking layer protocols, see e.g., first full paragraph in Section 3 on page 3.

For step (c), the proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Mazzola* by placing IP over the CLNP such that IP is transmitted over a DCC channel in the overhead of a synchronous optical frame. *Piscitello* further confirms that IP and CLNP are at the same networking layer.

In order to establish a *prima facie* case of obviousness for step (d), three basic criteria must be met. The three criteria according to MPEP 706.02(j) are as follows:

First there must be some suggestion or modification, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As such, for step (d) examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation placing IP over the Connection Less Network Protocol (CLNP). *Katz* also helps cure the deficiency by disclosing that IP maps (i.e., "translates") to CLNP [see section "Mapping IP functionality to CLNP" starting on page 44 of *Katz*]. In particular, *Katz* teaches "most functions of IP map directly to matching functions in CLNP" [page 44, middle right-hand column]. Thus *Katz* provides a relationship and thus provides a motivation by not only mapping IP and CLNP but also providing a mechanism for routing the two protocols [page 38] using an approach called TCP and UDP with Bigger Addresses (TUBA). Examiner notes *Katz*'s motivation for mapping IP and CLNP (see figure 10 of *Katz* on page 45) is due to problems with Internet growth and IP addressing. Examiner first notes that *Mazzola* provides a reasonable expectation of success by disclosing for illustrative purposes, the block diagrams (Fig. 4a and 4b) are specific for a SONET application; however, the method disclosed in a patent may be used in connection with other protocols as well for the physical layer, data layer, and network layer (e.g., examiner notes another protocol at the network layer to be IP) [column 5, lines 7-25]. Examiner notes with the mapping, the rest of the limitations fall into place given the combined

teachings of both references. Specifically, shown in Figure 8 of *Katz* is interarea routing for CLNP using IS-IS at the core and ES-IS at the edge. Furthermore, *Mazzola* also discloses routing for SONET/CLNP using ES-IS [column 1, lines 20-25]. Thus in summary, *Mazzola* discloses CLNP running over SONET-OSI (as is known in the art) and *Katz et al.* discloses IP running over “CLNP” thus IP can “run” over CLNP which runs over SONET-OSI. It would have been furthermore obvious to implement this knowledge over a set of routers in a network forming both a local gateway and a remote gateway as is well known in the art given a reasonable but broad interpretation of the claimed subject matter, and based on the examples provided by both references (e.g., shown in figure 2a of *Mazzola* and figure 6 of *Katz et al.*). Again, the motivation being that the Internet consists of more than one router as is well known in the art which forms local and remote gateways respectively (which could be directly or not directly attached) for a local and remote host. *Piscitello* provides further motivation that IP and CLNP are networking layer protocols, see e.g., first full paragraph in Section 3 on page 3.

As to **claims 3, 4**, specifically, data is routed using CLNP, and a tunnel is created using a reasonable but broad interpretation of the claimed subject matter. In addition, both *Mazzola* and *Katz et al.* disclose NSAP addressing. Examiner notes that EI-IS and IS-IS contain routing table(s). Furthermore, *Katz et al.* discloses mapping IP to NSAP addressing [pages 40-41]. As IP can be replaced by CLNP it is possible for the two to coexist.

Allowable Subject Matter

6. **Claim 27** is allowable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris
Examiner
Art Unit 2663


DWF


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SUPERVISORY PATENT EXAMINER
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